

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAISUKE ITO, YOSHIO NAKANE,
and KIMIAKI NAKADA

MAILED

DEC 28 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2005-2392
Application No. 09/933,197

HEARD: November 17, 2005

MAILED

DEC 28 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before FRANKFORT, PATE, and CRAWFORD, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7 and 9 through 24, all of the claims remaining in the application. Claim 8 has been canceled.

Appellants' invention relates to an electronic camera having a wireless communication device which transmits image data, and also wirelessly transmits operational information input on a control part of the camera to an external apparatus to remotely control the external apparatus, wherein the wireless communication device transmits at least one of the image data

and the operational information when the camera is within a predetermined distance of the external apparatus. In addition, the invention addresses an external apparatus which is remotely controlled by an electronic camera of the type noted above, and wherein the external apparatus includes a wireless communication device which communicates with the electronic camera to receive image data and accessory information attached to the image data, as well as operational information input on a control part of the camera, a processor configured to classify images received from the electronic camera into image groups according to the accessory information sent along with the image data and to create virtual folders for each of the image groups, and a display device which displays the virtual folders. The invention also relates to a remote-control operation system including an electronic camera and an external apparatus like those described above, and a method for wirelessly transmitting image data from an electronic camera to a remote device. A further understanding of the invention can be derived from a reading of independent claims 1, 2, 4, 5, 9, 11, 12, 15, 17, 23 and 24 on appeal, a copy of which claims appears in the "Appendix of Claims" attached to appellants' brief.

Appeal No. 2005-2392
Application No. 09/933,197

The prior art references relied upon by the examiner in
rejecting the appealed claims are:

Freeman et al. (Freeman)	5,579,239	Nov. 26, 1996
Matsumoto et al. (Matsumoto)	5,796,428	Aug. 18, 1998
Watanabe et al. (Watanabe)	5,953,481	Sep. 14, 1999
Peters	6,601,093	Jul. 29, 2003

(filed Dec. 1, 1999)

Claims 1, 3, 4, 6, 10, 12 through 14 and 16 stand rejected
under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in
view of Freeman.

Claims 2, 5, 7, 9, 11, 15 and 17 through 19 stand rejected
under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in
view of Freeman and Matsumoto.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being
unpatentable over Watanabe in view of Freeman as applied to claims
1, 4, 12 and 17 above, and further in view of Peters.

Claims 20 through 22 stand rejected under 35 U.S.C. § 103(a) as
being unpatentable over Watanabe in view of Freeman and Matsumoto
as applied above, and further in view of Peters.

Appeal No. 2005-2392
Application No. 09/933,197

Claim 23 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman and Peters.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman, Matsumoto and Peters.

Rather than attempt to reiterate the examiner's commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by appellants and the examiner regarding those rejections, we make reference to the answer (mailed October 18, 2004) for the examiner's reasoning in support of the rejections, and to appellants' brief (filed July 30, 2004) and reply brief (filed December 16, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that the examiner's

rejections before us on appeal will not be sustained. Our reasoning in support of that determination follows.

In rejecting claims 1, 3, 4, 6, 10, 12 through 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman, the examiner has determined that Watanabe discloses a reproducing apparatus having an editing function, wherein the apparatus includes a camera-integrated video tape recorder (VTR) that comprises a body (10), a control part (5) carried by the body and operable by a user, a communication device which transmits image data (col. 10, lines 16-20), and a wireless communication device (3) that transmits operation information corresponding with operation of the control part to an external apparatus (11) to remotely control the external apparatus (col. 9, line 61 - col. 10, line 38). What the examiner finds lacking in Watanabe is any teaching or suggestion of a wireless communication device which transmits image data. To account for this difference, the examiner looks to Freeman, urging that it discloses a remote video transmission system wherein image data is transmitted wirelessly from a camera-integrated device (1, 2) to an external apparatus (3). From the collective teachings of the applied patents, the examiner

concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention that the image data transmitted by Watanabe would be transmitted wirelessly, in the manner taught by Freeman, so communication would be made easier by being accessible in areas where standard lines are inaccessible.

In the brief and reply brief, appellants contend that neither Watanabe nor Freeman teach or suggest an electronic camera including a wireless communication device which transmits image data to an external apparatus. We agree. Watanabe expressly notes that the video and audio signals from the camera-integrated VTR (10) are transmitted to the external apparatus (stationary VTR 11) by way of "video and audio signal lines" and are recorded on a magnetic tape by the stationary VTR (col. 10, lines 16-20). Thus, the camera of Watanabe clearly has no wireless communication of image data, nor the apparent need for such capability.

Freeman likewise has no teaching or suggestion of an electronic camera including a wireless communication device which transmits image data to an external apparatus. In Freeman, while

the camera (1) outputs a video signal to the remote unit (2), there is no indication that this video signal is transmitted wirelessly to the remote unit (2), or that the camera (1) has any such capability. As noted in column 4, lines 7-9, it is within the separate remote unit (2) that the input from the camera is captured, compressed and digitized, and ultimately wirelessly sent to a remotely located host unit (3). To that end, the remote unit (2) is said to comprise

"a portable personal computer having a 486DX-2/66 motherboard, 10-inch plasma display, 210 MB notebook hard disk drive, MS DOS Vet. 6.2 operating system, Microsoft® Windows™ Ver. 3.1, Microsoft® Video for Windows, Procom Plus® for Windows, trackball bus mouse, high speed serial ports, 1 MB Windows accelerator video card, video capture card with capture module, audio capture card, SVGA to NTSC converter, SVGA video adapter. The remote unit also has up to four computer interfaces such a modems, each connected to a cellular telephone" (col. 4, lines 17-27).

Thus, Freeman at best discloses a system wherein a camera (1) may be connected to a portable personal computer (2) and download image and audio data to the computer, wherein it is the computer (2) that comprises means for digitizing and compressing the input data, storage of the digitized and compressed data file, and transmission of the data file over telephone lines, cellular, radio and other telemetric frequencies to a remotely located desktop computer (3). There is no teaching in Freeman

Appeal No. 2005-2392
Application No. 09/933,197

directed to an electronic camera including a wireless communication device to transmit video and operation information when the camera is within a predetermined distance of an external apparatus designed to receive and process such a wireless communication, as required in claim 1 on appeal. Nor does Freeman cure the deficiencies in Watanabe so as to render obvious the electronic camera set forth in claim 12 on appeal.

As for the external apparatus defined in appellants' claim 4 which is remotely controlled by an electronic camera and comprises a wireless communication device which communicates with the electronic camera, including receiving image data and operation information corresponding with operation of a control part provided on the electronic camera which is operated by a user of the camera, suffice to say that we see nothing in Watanabe and Freeman, considered individually or collectively, which teaches or suggests any such external apparatus.

From our perspective, the examiner has engaged in impermissible hindsight reconstruction by using appellants' claimed invention as a template to pick and choose among isolated disclosures and concepts in the applied prior art references and

then pieced those disparate disclosures/concepts together in an effort to render appellants' claimed invention obvious. This approach is impermissible, and thus the examiner's rejection of claims 1, 3, 4, 6, 10, 12 through 14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman will not be sustained.

Regarding the rejection of claims 2, 5, 7, 9, 11, 15 and 17 through 19 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman and Matsumoto, we note that Matsumoto discloses a camera or image capturing unit (101) that is connected directly to an image storage/display unit (102) by an external cable (col. 9, lines 35-39). Thus, this reference likewise does not teach or suggest an electronic camera including a wireless communication device which transmits image data to an external apparatus. Accordingly, electronic camera claims 5 and 17, and system claims 9 and 11 (which include such an electronic camera) would not have been rendered obvious to one of ordinary skill in the art by the combined or collective teachings of Watanabe, Freeman and Matsumoto.

Appeal No. 2005-2392
Application No. 09/933,197

Concerning external apparatus claims 2 and 15, for the reasons set forth on pages 24-27 and 32-36 of the brief, we agree with appellants that the prior art relied upon by the examiner fails to teach or suggest an external apparatus remotely controlled by an electronic camera and which comprises a wireless communication device which communicates with the electronic camera to receive image and accessory information attached to the image data from the camera, and a processor configured to classify images received from the electronic camera into image groups according to the accessory information attached and related to the image data and to create virtual files for each of the groups classified.

For the reasons noted above, we agree with appellants that the examiner has failed to make out a *prima facie* case of obviousness, and therefore will not sustain the rejection of claims 2, 5, 7, 9, 11, 15 and 17 through 19 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman and Matsumoto.

Appeal No. 2005-2392
Application No. 09/933,197

Nor will we sustain the examiner's rejections of dependent claims 20 through 22 and independent claims 23 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Freeman and Peters, or Watanabe in view of Freeman, Matsumoto and Peters. Simply stated, nothing in the examiner's explanation of these rejections (answer, pages 8-9) or in the disclosure of Peters overcomes the shortcomings in the combined teachings of the applied patents already discussed above. See also pages 36-44 of the brief for appellants' arguments against these rejections. Again, we find that the examiner has impermissibly used appellants' own teachings as a roadmap or template for combining disparate elements and concepts from the applied prior art references in an effort to reconstruct the claimed invention.

Appeal No. 2005-2392
Application No. 09/933,197

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

CEF/jrg